OIPE IAP41
JUN 26 2006
PATENT & TRADEMARK OFFICE

IFW

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/681,413
Filing Date	10/07/2003
First Named Inventor	A. Yonezawa et al.
Art Unit	1734
Examiner Name	M. Osele
Attorney Docket Number	KIN94USA
Total Number of Pages in This Submission	16

ENCLOSURES *(Check all that apply)*

☑ Fee Transmittal Form
- ☑ Fee Attached

☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)

☐ Extension of Time Request
☐ Express Abandonment Request
☐ Information Disclosure Statement
☐ Certified Copy of Priority Document(s)
☐ Reply to Missing Parts/ Incomplete Application
- ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

☐ Drawing(s)
☐ Licensing-related Papers
☐ Petition
☐ Petition to Convert to a Provisional Application
☐ Power of Attorney, Revocation Change of Correspondence Address
☐ Terminal Disclaimer
☐ Request for Refund
☐ CD, Number of CD(s) ____________
- ☐ Landscape Table on CD

☐ After Allowance Communication to TC
☐ Appeal Communication to Board of Appeals and Interferences
☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
☐ Proprietary Information
☐ Status Letter
☐ Other Enclosure(s) (please Identify below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Howson and Howson		
Signature			
Printed name	George A. Smith, Jr.		
Date	06/22/2006	Reg. No.	24,442

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	George A. Smith, Jr.	Date	06/22/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

OIPE IAP41
JUN 26 2006
PATENT & TRADEMARK OFFICE

PTO/SB/17 (01-06)
Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT	($)	500.00

Complete if Known	
Application Number	10/681,413
Filing Date	10/07/2003
First Named Inventor	A. Yonezawa et al.
Examiner Name	M. Osele
Art Unit	1734
Attorney Docket No.	KIN94USA

METHOD OF PAYMENT (check all that apply)

☑ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): ____________

☑ Deposit Account Deposit Account Number: 08-3040 Deposit Account Name: Howson and Howson

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☑ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☑ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
Application Type	**Fee ($)**	**Small Entity Fee ($)**	**Fee ($)**	**Small Entity Fee ($)**	**Fee ($)**	**Small Entity Fee ($)**	**Fees Paid ($)**
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	**Fee ($)**	**Small Entity Fee ($)**
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee ($)** **Fee Paid ($)**
______ - 20 or HP = ______ x ______ = ______
HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee ($)** **Fee Paid ($)**
______ - 3 or HP = ______ x ______ = ______
HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims
Fee ($) ______ **Fee Paid ($)** ______

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee ($)** **Fee Paid ($)**
______ - 100 = ______ / 50 = ______ (round up to a whole number) x ______ = ______

4. OTHER FEE(S) **Fees Paid ($)**

Non-English Specification, $130 fee (no small entity discount) ______

Other (e.g., late filing surcharge): Brief on appeal $500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 24,442	Telephone 215-540-9200
Name (Print/Type)	George A. Smith, Jr.		Date 06/22/2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

OIPE IAP41
JUN 26 2006
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.: 10/681413
Applicant: A. Yonezawa et al.
Filed: 10/07/2003
TC/A.U.: 1734
Examiner: M. Osele
Docket No.: KIN94USA
Customer No. 00270

Confirmation No: 7415

BRIEF ON APPEAL

MAIL STOP Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is from the final rejection of claims 1-3 in the Office Action dated January 13, 2006.

A check for the fee of $500.00 for filing this Appeal Brief is attached. The Commissioner is hereby requested to charge any deficiency in the fee due with the filing of this paper, or credit any overpayment, to our Deposit Account, No. 08-3040.

The notice of appeal and a request for a month's extension of time were mailed with a certificate of mailing on May 11, 2006, and filed in the PTO on May 15, 2006. This brief is therefore timely. However, please grant an

06/27/2006 BABRAHA1 00000015 10681413
01 FC:1402 500.00 OP

extension of time if necessary, and charge any extension fee to the above-mentioned deposit account.

I. REAL PARTY IN INTEREST

The real party in interest is the Applicant's Assignee, Fujicopian Co., Ltd., a Japanese corporation located at 4-14, Mitejima 5-chome, Nishi-Yodogawa-ku, Osaka-shi, Osaka-fu, Japan. Fujicopian Co., Ltd. acquired title by an assignment recorded at Reel 016601 frame 0770.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

The pending claims are claims 1-3.

IV. STATUS OF AMENDMENTS

An amendment was filed following the final rejection. The Examiner agreed to enter the amendment for the purpose of appeal. Therefore, the claims as they appear in the claims appendix include the amendment.

V. SUMMARY OF CLAIMED SUBJECTION MATTER

A familiar embodiment of a coating film transfer tool is a correction tape applicator, used to apply a narrow strip of opaque white film to a sheet of paper. The film is supplied as a coating on a "base tape," which is unwound from a supply reel and wound onto a take-up reel after passing a transfer head.

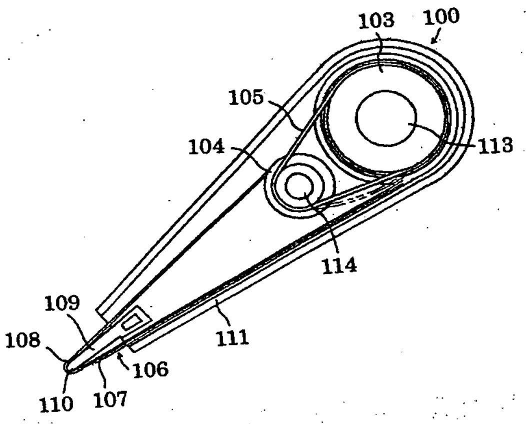
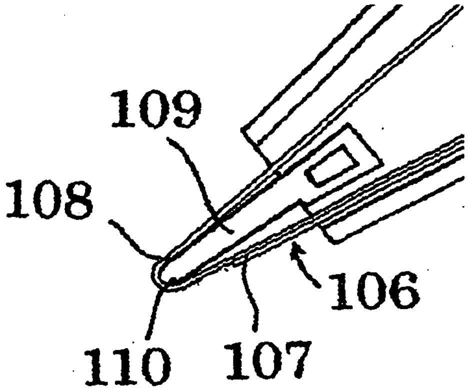


FIG. 2
PRIOR ART



Enlargement of
part of FIG. 2

Referring to FIG. 2, a typical coating film transfer tool comprises a supply reel 103, a take-up reel 104, and a transfer head 109. A base tape 108, coated with a coating film 107, moves from the supply reel, past the tip 110 of the transfer head, to the take-up reel. An endless rubber belt 105 connects a pulley on the supply reel to a pulley on the take-up reel to rotate the take-up reel as tape is unwound from the supply reel. Some slippage of the belt is permitted.

The invention addresses a common problem encountered in the operation of a coating film transfer tool. The problem is that, when the transfer head is lifted from the receiving surface, the base tape tends to be pulled back toward the supply reel, producing a space (typically about 3mm) between the leading end of the coating film and the tip of the transfer head, as shown in FIG. 2. The next time the device is used, the coating film will not reach the transfer head until the transfer head is moved about 3mm while the tape is pressed against the receiving surface. Thus, the user must predict a starting position on the receiving surface at which transfer of coating film will begin, and press the transfer head onto the receiving surface at a location appropriately spaced from the starting position.

The inventors observed that the pull-back phenomenon results from a build-up of tension in the section of the drive belt that travels from the pulley on the take-up reel toward the pulley on the supply reel. When the transfer head is lifted, equalization of the tension in both sides of the drive belt rotates the supply reel backward, causing the tape to be pulled back.

The inventors' solution, depicted in FIG. 1, is to provide a belt guide 2, in contact with the section of the belt that moves from the supply reel toward the take-up reel[1], that is, the section opposite to the section in which the tension that causes pull-back builds up.

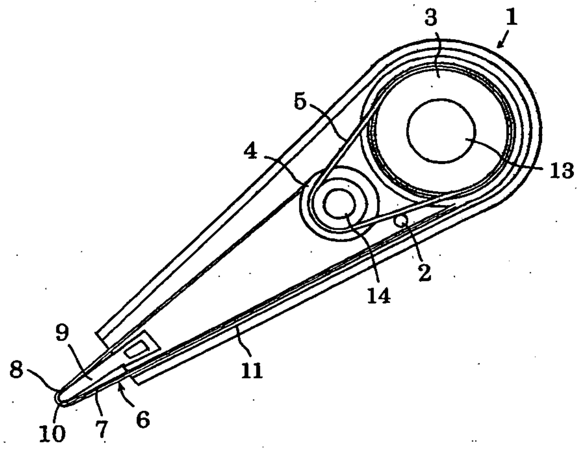


FIG. 1

The belt guide improves the balance of tension in the two sections of the belt. Although an exact balance cannot be achieved, an improvement in the balance between the tension in the section of the belt moving toward the supply reel and the tension in the section of the belt moving toward the take-up reel can be realized. This simple measure has been found to reduce pull-back from about 3 mm to as little as about 0.5 mm[2].

---

[1] FIG. 2, page 5, lines 16-19, and page 5, lines 7-19

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection under 35 U.S.C. §112 has been overcome by amendment.

The only remaining rejection is the rejection of claims 1-3 under 35 U.S.C. §103 on Stevens (US 5,568,450), Masahiko (JP 6-127774) and Hoffman et al. (US 5,328,510).

VII. ARGUMENT

The issue on appeal

The issue in this appeal is whether or not the Examiner erred in his implicit conclusion that the differences between the claimed subject matter and the prior art of record are such that the claimed subject matter, as a whole, would have been obvious to a person having ordinary skill in the art of coating film transfer tool design.

Claim 1 is a Jepson-type claim. The preamble and the four paragraphs that follow the preamble encompass the prior art coating film transfer tool of FIG. 2. The final paragraph defines the improvement:

---

[2] See table on page 6 of specification.

> "wherein a belt guide for guiding said belt is disposed between the supply reel and the take-up reel, in contact with a section of the belt which moves from the pulley of the supply reel to the pulley of the take-up reel when the supply reel rotates in said first direction."

In simple terms, the Board must decide whether or not the prior art fairly teaches that a guide should be provided on the side of the belt that moves from the supply reel to the take-up reel.

The prior art

Stevens describes a conventional coating film transfer tool that is essentially equivalent to the prior art tool depicted in the Applicants' FIG. 2. It has no guide.

Masahiko describes a similar transfer tool, but Masahiko's tool has a roller 17 in contact with the section of the drive belt that travels from the take-up reel toward the supply reel. The roller is mounted eccentrically on a rotatable plate for adjustment of slip torque.

Hoffman describes an apparatus for coating a traveling paper substrate with a polymer such as polyethylene, or with clay. A polymer release film is maintained in contact with the traveling paper substrate through a portion of its travel. In one embodiment, shown in FIG. 5, the polymer release film is wound onto a wind-up roll 60 along with the coated paper substrate. As an alternative, the polymer release film can be in the form of a belt (72) and re-used, as shown in FIGs. 6 and 7. In the case of a belt, a tension roll (55) is provided "to compensate for stretching which occurs in the belt during use." (Hoffman, col. 8, lines 36-38.)

The rejection under 35 U.S.C. § 103(a)

In the rejection, the Examiner acknowledges that neither Stevens nor Masahiko teaches a guide in contact with the section of the belt that moves from the supply reel toward the take-up reel. However, the rejection asserts that it would have been obvious to provide a guide in that position because Hoffman's guide is on the side of the belt 72 that moves from the large "pulley"[3] 56 to the small "pulley" 54, and because "Hoffman et al. shows this to be a functionally equivalent alternative expedient to the placement of the pressing roller of Masahiko."

Reasons why the invention would not have been obvious

First, the primary function of the belt 72 in Hoffman is to maintain a layer of polyethylene or clay against a paperboard substrate. It does not appear that the belt performs a driving function analogous to that of the belts in Stevens and Masahiko. In fact, Hoffman does not explain which of the rollers in FIGs. 6 and 7 is power-driven.

Nothing in the prior art of record suggests that the drive belt in a coating film transfer tool stretches significantly over time as does the belt in the paperboard coater of the Hoffman patent. Furthermore, it is reasonable to assume that Hoffman's roller 55, if it is to "compensate for stretching which occurs in the belt during use," must be a movable roller associated with some sort of tensioning mechanism operated by a spring, a weight, a compressed air cylinder, or the like. A person having ordinary skill in the art would not want to go to the trouble of providing a complicated tensioner in a coating film tool, especially if stretching of the belt over time is not a significant problem. Therefore, Hoffman does not provide a reason to utilize a roller (corresponding to Hoffman's roller 55 (FIGs. 6 and 7)) on either side of a belt in a coating film transfer tool.

---

[3] Hoffman describes part 56 as a "hot drum" or as a "dryer roll," and part 54 as a "backing roll." Neither is a "pulley."

The purpose of the torque varying mechanism 14 in Masahiko is to adjust slip, so that the device can be operated with a "light operating force" as the diameter of the tape wound on the supply reel decreases and the diameter of the tape wound on the take-up reel increases. In Masahiko, the torque varying mechanism 14 is on the side of the belt that moves from the take-up reel toward the supply reel. If the torque varying mechanism were instead placed on the side of the belt that moves from the supply reel to the take-up reel, part of its range of motion would be utilized merely in taking up the slack created when the transfer tool is operated. In that position, the torque varying mechanism would be less effective in controlling slippage of the belt on the pulleys, and would not be expected to adjust slip satisfactorily.

For the above reasons, neither Hoffman nor Masahiko supplies a motivation that would lead to placement of a belt guide on the slack side in a coating film tool. Nothing in any of the three references suggests the concept of achieving an improved balance between the tensions on the two sides of a coating film tool drive belt or the advantage of doing so: the reduction of pull-back.

Response to remarks in advisory action

In the advisory action, the Examiner maintained the rejection, asserting that, "the tension roller of Masahiko would be effective regardless of its location. An adjustable tension roller is not too complex for a hand held transfer tool as evidenced by the tension roller on an eccentric in the apparatus of Masahiko."

As for the first point, it is not clear whether the Examiner considers the repositioning of Masahiko's roller 17 to be effective for Masahiko's purpose or for the applicant's purpose. If the former, the answer, as stated above, is that if the roller is on the side of the belt that moves toward the take-up reel, the roller would be much less effective for the purpose of adjusting belt slippage than it would be if positioned on the side that moves toward the supply reel. On the other hand, if the Examiner is arguing that the repositioning of the eccentrically mounted roller would be effective for the present inventors' purpose (reducing pull-back), we would agree that it would be effective, but the argument is impermissible because it relies on the present inventors' own disclosure[4].

The second point was made in response to the Applicants' argument that Hoffman's compensating roller must be associated with some kind of tensioner such as a spring, a weight, or the like, and such an arrangement would be too complicated to be practical in a hand-held transfer tool. A spring-loaded or weight-loaded roller, as in Hoffman, is quite different from the simple, eccentrically mounted, manually adjustable roller in

---

[4] Because section 103 requires obviousness to be assessed as of "the time the invention was made," it inherently prohibits reliance on the inventors' own disclosure.

Masahiko. Moreover, as pointed out above, there is no indication in the prior art that compensation for belt stretch is needed in a coating film transfer tool.

Conclusion

There is no teaching in the prior art that would have motivated a person having ordinary skill in the art to provide a guide in contact with a section of drive belt that moves from a coating film supply reel to a take-up reel. The Examiner erred in rejecting claim 1 under §103, and the rejection should be reversed.

Respectfully submitted,
HOWSON & HOWSON

By
George A. Smith, Jr.
Reg. No. 24,442
Howson & Howson
Box 457
Spring House, PA 19477
Telephone: 215 540 9200
Facsimile: 215 540 5818

Enclosures:
(a) appeal fee

CLAIMS APPENDIX

1. A coating film transfer tool comprising:

a supply reel having a transfer tape wound thereon, the transfer tape comprising a base tape coated with a coating film;

a transfer head for pressing the transfer tape against a receiving surface to transfer the coating film thereto;

a take-up reel for taking up used base tape, said base tape extending from the supply reel, past the transfer head, to the take-up reel and being capable of exerting a pulling force tending to unwind base tape from the supply reel when the transfer head is moved over a receiving surface and thereby causing the supply reel to rotate in a first direction; and

a driving mechanism comprising a first belt-engaging pulley on the supply reel, a second belt-engaging pulley on the take-up reel, and an endless belt frictionally engaged with both pulleys, capable of slipping on the belt-engaging pulley on the take-up reel, and cooperatively connecting the supply reel in driving relationship with the take-up reel, the diameter of the first pulley being greater than the diameter of the second pulley, whereby the rate of rotation of the take-up reel, when driven through the belt by the supply reel would be greater than the rate of rotation of the supply reel, if the take-up reel were not constrained by the base tape extending from the supply reel, past the transfer head, to the take-up reel;

wherein a belt guide for guiding said belt is disposed between the supply reel and the take-up reel, in contact with a section of the belt which moves from the pulley of the supply reel to the pulley of the take-up reel when the supply reel rotates in said first direction.

2. The coating film transfer tool according to claim 1, wherein the belt guide is a roller.

3. The coating film transfer tool according to claim 1, wherein the belt guide is a cylindrical roller.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None